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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/267,025	03/11/1999	RODNEY M. SHIELDS	TF-2018-03-R	6529

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EXAMINER	
WATKINS III, WILLIAM P	

ART UNIT	PAPER NUMBER
1772	43

DATE MAILED: 12/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No.	Applicant(s)
	09/267,025	SHIELDS, RODNEY M.
	Examiner	Art Unit
	William P. Watkins III	1772

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires *3* months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1.☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2.☐ The proposed amendment(s) will not be entered because:

(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);

(b) ☐ they raise the issue of new matter (see Note below);

(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3.☒ Applicant's reply has overcome the following rejection(s): see the attachment.

4.☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5.☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *see the attachment*.

6.☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7.☒ For purposes of Appeal, the proposed amendment(s) a)☐ will not be entered or b)☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: *1-5, 7, 9, 11-12, and 22-70*.

Claim(s) withdrawn from consideration: _____.

8.☐ The drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9.☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10.☐ Other: _____

Attachment to Advisory Action Paper No. 42

The responses below follow the section headings in the amendment filed 24 November 2003.

I. The power of attorney has been accepted.

II. The objection regarding the consent of the assignee is withdrawn in view of the new consent form that has been filed.

III. Noted.

IV. No 1449 is attached to the amendment. The request is repeated.

V. Noted.

VI. The examiner maintains the position that *In re Clement, 45 USPQ2d 1161 (Fed. Cir 1997)* controls the facts of this case. The examiner does not state a per se rule that no recapture of surrendered subject matter is allowed, but instead is of the position that applicant's actions in this case are an admission that the scope of the claims abandoned were in fact not

patentable. As stated by the examiner on page 9 of the office action mailed 24 September 2003 limitations were "added by applicant late in the prosecution of the parent case to overcome the applied art rejection". The cases cited by applicant can be distinguished from the instant facts. In *Seattle Box v. Industrial*, 221 USPQ 568, 571 (Fed. Cir. 1984) "neither the patent examiner nor the cited prior art required the narrow scope of the issued claims". This is not true in the instant case were the examiner applied art that was avoided by applicant's amendment that narrowed the claim. In *In re Wilder et al.*, 222 USPQ 369, 371 (Fed. Cir. 1984), also is not on point in that the original claims were overly narrow because no patentability search had been preformed. The mistake of the attorney was to presume the results of a patentability search before writing the original claims, not in allegedly misjudging the strength of an obviousness rejection and amending the claims as in the instant application. The position of the examiner is that *Morey v. Lockwood*, 75 U.S. 230 (1868), can also be distinguished from the instant facts. In *Morey* the patent office cited a printed publication that represented an actual machine being marketed that was silent on the nature of the tubing used. The office presumed the tubing was flexible and suggested applicant add a further limitation. Latter it was

shown that the actual tubing of the prior art was metal and that the publication cited could therefore not have taught flexible tubing. The office admitted this actual error involving the description of an actual machine that was relied upon by inference as prior art. The office has admitted no error in this case. Claim 15 of the Reexam Certificate of Hill '609, has been found to be supported in the original specification of Hill '609 by both the Reexam examiner and the examiner of the reissue of Hill '609 (RE37186). Claim 15 of Hill '609 was applied against the claims of the instant parent application (office action mailed 23 August 1995 in the 08/324,889 parent), before applicant amended the narrowing limitations into the claims of the parent. At best, if there is error on the part of applicant, it is the failure to press the current arguments that claim 15 of Hill '609 is not supported in the original specification of Hill '609 in the instant parent application and instead deciding to narrow the claims. This narrowing is a classic example of the intent of the applicant at the time to abandon the original subject matter as unpatentable, which is the basis of the recapture prohibition doctrine.

VII. The rejection is maintained. Applicant is asked to point exactly which passages of the patent support each individual

member of the Markush group. A cursory review of the passages cited by applicant indicated that most are drawn to light and dark coatings without reference to these coatings being adhering means.

VII. Noted.

IX. The rejection 112 antecedent basis rejection is withdrawn in view of applicant's amendments.

X. Applicant presents the argument that Hill '609 claim 15 is new matter to the original specification of Hill '609. As noted above in the recapture section PTO examiners in the Reexam and Ressiue proceeding regarding Hill'609 have twice addressed this argument and support for the claim has been found. At best applicant argues that a preponderance of multiple bits of evidence contradicts the findings of the PTO examiners in the Hill cases. The claims of the Hill Reexam have a presumption of validity absent clear and convincing evidence to the contrary.

At page 22 of the instant amendment applicant argues that, at best, the passage (col. 13) argued by Hill to support claim 15 as not being new matter may render claim 15 obvious but not supported under the written description requirement. The

examiner notes that as regards the instant art rejection, the original specification of Hill '609 supporting claim 15 of Hill '609 as being obvious, would render the instant claims obvious over the original specification of Hill, even if claim 15 of Hill is new matter in Hill.

The art rejection in section 19 of the office action mailed 24 September 2003, in the instant case, lays out the rational that transparent areas can formed through the reflective and absorptive layers of a panel by perforation through all of these layers as taught in col. 13 of Hill '609. Though col. 13 of Hill does not teach external adhesive layers and release liners, these features are present in many of the nonperforated embodiments of Hill '609 and would be obvious to use with the perforated embodiments taught in Hill '609 as the same type of final mounted application is taught for both perforated and non-perforated embodiments. As an adhesive that joins the vision panel to a window would have to have transparent areas in alignment with the transparent areas formed by the perforations of the vision panel, it would have been obvious to also form those transparent areas by perforation, as this is a method clearly taught to form transparent areas in col. 13 of Hill '609. In column 13 of Hill, perforation before or after coating of a design is taught. Perforation after a design is coated

would involve simultaneous perforation of the coating and base panel substrate. This teaches the concept of simultaneous perforation, which would be easily applied to other needed layers that require perforation such as adhesive layers. Thus the position of the examiner remains that the instant claims are obvious over Hill '609.

XI. Applicant argues no motivation to combine. The rejection is based on substitution of structures, which have similar functions in similar applications being within the ordinary skill of the art.

XII. Applicant argues no motivation to combine. The motivation to provide a three dimensional effect is given.

XIII. Applicant argues nonanalogous art. Bogner deals with a common problem, which is manipulation of sheets that need to have designs printed on them.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Watkins III whose telephone number is 703-308-2420 (changes to 571-272-1503 as of Jan. 04). The examiner works an increased flex time schedule, but can normally be reached Monday through Friday, 11:30 A.M. through 8:00 P.M. Eastern Time. The examiner

returns all calls within one business day unless an extended absence is noted on his voice mail greeting.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 703-308-4251. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.

WW/ww
December 23, 2003

WILLIAM P. WATKINS III
PRIMARY EXAMINER